

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

ATTORNEYS AT LAW

1100 NEW YORK AVENUE, N.W. • WASHINGTON, D.C. 20005-3934

PHONE: (202) 371-2600 • FACSIMILE: (202) 371-2540 • www.skgf.com

JC978 U.S. PTO
09/829066
04/10/01

ROBERT GREENE STERNE
EDWARD J. KESSLER
GEORGE A. GOLDSTEIN
SAMUEL L. FOX***
DAVID K.S. CORNWELL
ROBERT W. ESMOND
TRACY-GENE G. DURKIN
MICHELE A. CIMBALA
MICHAEL B. RAY
ROBERT E. SOKOHL
ERIC K. STEFFE
MICHAEL Q. LEE
STEVEN R. LUDWIG

JOHN M. COVERT*
LINDA E. ALCORN
ROBERT C. MILLONIG
MICHAEL V. MESSINGER
JUDITH U. KIM
TIMOTHY J. SHEA, JR.
DONALD R. MCPHAIL
PATRICK E. GARRETT
STEPHEN G. WHITESIDE
JEFFREY T. HELVEY*
HEIDI L. KRAUS
JEFFREY R. KURIN
RAYMOND MILLIEN

PATRICK D. O'BRIEN
LAWRENCE B. BUGAISKY
CRYSTAL D. SAYLES
EDWARD W. YEE
ALBERT L. FERRO*
DONALD R. BANOWIT
PETER A. JACKMAN
MOLLY A. MCCALL
TERESA U. MEDLER
JEFFREY S. WEAVER
KRISTIN K. VIDOVICH
KENDRICK P. PATTERSON
DONALD J. FEATHERSTONE

GRANT E. REED
VINCENT L. CAPUANO
JOHN A. HARROUN*
ALBERT J. FASULO II*
W. BRIAN EDGE*
ELOORA ELLISON FLOYD*
W. RUSSELL SWINDELL
THOMAS C. FIALA
LONNY L. MULLER*
BRIAN J. DEL BUONO*
VIRGIL L. BEASTON*
RYAN J. STAMPER*

KAREN R. MARKOWICZ**
SUZANNE E. ZISKA**
ANDREA J. KAMAGE**
NANCY J. LEITH**
ELIZABETH J. HAANES**
MARK P. TERRY**

*BAR OTHER THAN D.C.
**REGISTERED PATENT AGENT
***SENIOR COUNSEL

April 10, 2001

WRITER'S DIRECT NUMBER:

(202) 371-2560

INTERNET ADDRESS:

RESMOND@SKGF.COM

Commissioner for Patents
Washington, D.C. 20231

Box Patent Application

Re: U.S. Non-Provisional Utility Patent Application under 37 C.F.R. § 1.53(b)
Appl. No: To be assigned (continuation of 09/103,577, filed June 24, 1998,
allowed)
Filed: April 10, 2001
For: **Method for Isolating and Recovering Target DNA or RNA
Molecules Having a Desired Nucleotide Sequence**
Inventors: P. Nisson *et al.*
Our Ref: 0942.4800002/RWE/ALS

Sir:

The following documents are forwarded herewith for appropriate action by the U.S.
Patent and Trademark Office:

1. PTO Fee Transmittal (Form PTO/SB/17) (*in duplicate*);
2. PTO Utility Patent Application Transmittal (Form PTO/SB/05);
3. U.S. Utility Patent Application entitled:

**Method for Isolating and Recovering Target DNA or RNA Molecules Having
a Desired Nucelotide Sequence**

and naming as inventors:

Commissioner for Patents
April 10, 2001
Page 2

Paul E. NISSON, Joel JESSE, and Wu-bo LI

the application consisting of:

- a A specification containing:
- i. 46 pages of description prior to the claims
(including a sequence listing on pages 42 to 46);
 - ii. 4 pages of claims (40 claims);
 - iii. a one (1) page abstract;
- b 3 sheets of drawings: (Figures 1-3); and
- c. A copy of the executed combined Declaration and Power of Attorney, as originally filed in parent U.S. Appl. No. 09/103,577;
4. Application Data Sheet;
 5. A Preliminary Amendment;
 6. Amendment and Submission of Substitute Sequence Listing Under 37 C.F.R. § 1.825(a);
 7. 4 pages of a paper copy of a sequence listing;
 8. A computer readable copy of the sequence listing;
 9. Letter to PTO Draftsman: Submission of Formal Drawings (*in duplicate*);
 10. Three (3) sheets of Formal Drawings (Figs. 1-3);
 11. Authorization to Treat a Reply As Incorporating an Extension of Time Under 37 C.F.R. § 1.136(a)(3) (*in duplicate*);
 12. A copy of the Assignment as originally filed in parent U.S. App. No. 09/103,577;
 13. A copy of the executed Power of Attorney from Assignee as originally filed in parent U.S. Appl. No. 09/103,577;

100-496360

Commissioner for Patents
April 10, 2001
Page 3

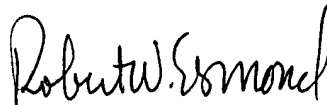
14. A copy of the certificate under 37 C.F.R. § 3.73(b) as originally filed in parent U.S. Appl. No.09/103,577;
15. Revocation of Prior Power of Attorney and Appointment of New Attorneys of Record, as originally filed in parent U.S. Appl. No. 09/103,577;
16. A copy of the merger document between Life Technologies, Inc. and Invitrogen Corporation, recorded against parent U.S. Appl. No. 09/103,577 at Reel 011452, Frame 0123;
17. Two (2) return postcards; and
18. Our check No. 30909 for \$ 1,610.00 to cover:
\$ 710.00 Filing fee for patent application; and
\$ 900.00 Fee for excess claims.

In accordance with 37 C.F.R. § 1.821(f), the paper copy of the sequence listing and the computer readable copy of the sequence listing submitted herewith in the above application are the same.

It is respectfully requested that, of the two attached postcards, one be stamped with the filing date of these documents and returned to our courier, and the other, prepaid postcard, be stamped with the filing date and unofficial application number and returned as soon as possible. The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036. A duplicate copy of this letter is enclosed.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Robert W. Esmond
Attorney for Applicants
Registration No. 32,893

RWE/ALS/asl
Enclosures

Under the Patent Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

FEE TRANSMITTAL for FY 2001

Patent fees are subject to annual revision.

Complete if Known

Application Number	To be assigned (Cont. of 09/103,577, filed June 24, 1998, allowed)
Filing Date	April 10, 2001
First Named Inventor	Paul E. NISSON
Examiner Name	To be assigned
Group Art Unit	To be assigned
Attorney Docket No.	0942.4800002/RWE/ALS

TOTAL AMOUNT OF PAYMENT \$ 1,610.00

METHOD OF PAYMENT (check one)

1. ☐ The Commissioner is hereby authorized to charge indicated fees and credit any overpayment to:

Deposit Account Number 19-0036
Deposit Account Name Sterne, Kessler, Goldstein & Fox P.L.L.C.

- ☐ Charge Any Additional Fee Required Under 37 CFR §§ 1.16 and 1.17

- ☐ Applicant claims small entity status See 37 CFR 1.27

2. ☒ Payment Enclosed:

- ☒ Check ☐ Credit card ☐ Money Order ☒ Other*

*Charge any deficiencies or credit any overpayments in the fees or fee calculations of Parts 1, 2 and 3 below to Deposit Account No. 19-0036.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description	Fee Paid
101	710	201	355	Utility filing fee	\$710.00
106	320	206	160	Design filing fee	
107	490	207	245	Plant filing fee	
108	710	208	355	Reissue filing fee	
114	150	214	75	Provisional filing fee	
SUBTOTAL (1) (\$)					710.00

2. EXTRA CLAIM FEES

Total Claims	Extra	Fee from below	Fee Paid
70	-20** = 50	X 18.00 =	\$900.00
Indep. Claims 3	- 3** = 0	X 0 =	\$0
Multiple Dependent			\$0

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description
103	18	203	9	Claims in excess of 20
102	80	202	40	Independent claims in excess of 3
104	270	204	135	Multiple dependent claim
108	80	209	40	**Reissue independent claims over original patent
110	18	210	9	**Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$) 900.00

** or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description	Fee paid
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for <i>ex parte</i> reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for reply within first month	
116	390	216	195	Extension for reply within second month	
117	890	217	445	Extension for reply within third month	
118	1,390	218	695	Extension for reply within fourth month	
128	1,890	228	945	Extension for reply within fifth month	
119	310	219	155	Notice of Appeal	
120	310	220	155	Filing a brief in support of an appeal	
121	270	221	135	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidable	
141	1,240	241	620	Petition to revive - unintentional	
142	1,240	242	620	Utility issue fee (or reissue)	
143	440	243	220	Design issue fee	
144	600	244	300	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	
123	130	123	130	Petitions related to provisional applications	
126	180	126	180	Submission of Information Disclosure Stmt	
581	40	481	40	Recording each patent assignment per property (times number of properties)	
146	710	246	355	Filing a submission after final rejection (37 CFR 1.129(a))	
149	710	249	355	For each additional invention to be examined (37 CFR 1.129(b))	
179	710	279	355	Request for Continued Examination (RCE)	
169	900	169	900	Request for expedited examination of a design application	
Other fee (specify):					
Other fee (specify):					
*Reduced by Basic Filing Fee Paid					
SUBTOTAL (3) (\$)					

SUBMITTED BY

Complete (if applicable)

Name (Print/Type)	Robert W. Esmond	Registration No. (Attorney/Agent)	32,893	Telephone	202-371-2600
Signature	Robert W. Esmond	Date	April 10, 2001		

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND

Please type a sign (+) inside this box

PTO/SB/05 (11-00)

Approved for use through 10/31/2002. OMB 0651-0032
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

UTILITY PATENT APPLICATION TRANSMITTAL

(Only for new nonprovisional applications under 37 CFR § 1.53(h))

Attorney Docket No.	0942.4800002/RWE/ALS
First Inventor	Paul E. NISSON
Title	Method for Isolating and Recovering Target DNA or RNA Molecules Having a Desired Nucleotide Sequence
Express Mail Label No.	

APPLICATION ELEMENTS
See MPEP chapter 600 concerning utility patent application contents.

ADDRESS TO:

Assistant Commissioner for Patents
Box Patent Application
Washington, DC 20231

1. ☒ Fee Transmittal Form (e.g., PTO/SB/17)
(Submit an original, and a duplicate for fee processing)
2. ☐ Applicant claims small entity status.
See 37 CFR 1.27.
3. ☒ Specification [Total Pages: 51]
4. ☒ Drawing(s) (35 U.S.C. 113) [Total Sheets: 3]
5. ☒ Oath or Declaration [Total Pages: 3]
 - a. ☐ Newly executed (original or copy)
 - b. ☒ Copy from a prior application (37 CFR 1.63(d))
(for continuation/divisional with Box 17 completed)
 - i. ☐ **DELETION OF INVENTOR(S)**
Signed statement attached deleting inventor(s)
named in the prior application, see 37 CFR §§
1.63(d)(2) and 1.33(b).
6. ☒ Application Data Sheet. See 37 CFR 1.76.

7. ☐ CD-ROM or CD-R in duplicate, large table or Computer Program
(Appendix)
8. Nucleotide and/or Amino Acid Sequence Submission
(if applicable, all necessary)
 - a. ☒ Computer Readable Form (CRF)
 - b. Specification Sequence Listing on:
 - i. ☐ CD-ROM or CD-R (2 copies); or
 - ii. ☒ paper
 - c. ☒ Statements verifying identity of above copies

JC978 U.S. PTO
09/829066
04/10/01

ACCOMPANYING APPLICATION PARTS

9. ☒ Assignment Papers [Total pages: 2]
10. ☒ 37 CFR 3.73(b) Statement ☒ Power of Attorney
(when there is an assignee)
11. ☐ English Translation Document (if applicable)
12. ☐ Information Disclosure Statement (IDS)/PTO-1449 ☐ Copies of IDS Citations
13. ☒ Preliminary Amendment
14. ☒ Return Receipt Postcard (MPEP 503)
(Should be specifically itemized)
15. ☐ Certified Copy of Priority Document(s)
(if foreign priority is claimed)
16. ☐ Request and Certification under 35 U.S.C. 122 (b)(2)(B)(i). Applicant must attach
form PTO/SB/35 or its equivalent.
17. ☒ Other: Authorization under 37 C.F.R. § 1.136(a)(3)
☒ Other: Revocation of Prior Power of Attorney and Appointment of New
Attorneys of Record as filed in parent U.S. Appl. No. 09/103,577; and
a copy of the merger document between Life Technologies, Inc. and
Invitrogen Corporation, recorded against U.S. Appl. No. 09/103,577 at
Reel 011452, Frame 0123.

18. If a CONTINUING APPLICATION, check appropriate box, and supply the requisite information below and in a preliminary amendment,
or in an Application Data Sheet under 37 CFR 1.76:

☒ Continuation ☐ Divisional ☐ Continuation-in-Part (CIP) of prior application No: 09/103,577

Prior application information: Examiner: S. Houtteman Group/Art Unit: 1656

For CONTINUATION OR DIVISIONAL APPS only: The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is
considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only
relied upon when a portion has been inadvertently omitted from the submitted application parts.

18. CORRESPONDENCE ADDRESS

☒ Customer Number or Bar Code Label
Customer No. 26111



or ☐ Correspondence address below

26111

(Insert Customer Number or Bar Code Label here)

NAME	STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.		
	Attorneys at Law		
ADDRESS			
CITY	STATE	ZIP CODE	
COUNTRY	TELEPHONE	FAX	

NAME (Print/Type)	Robert W. Esmond	Registration No. (Attorney/Agent)	32,893
SIGNATURE	<u>Robert W. Esmond</u>	Date	<u>April 10, 2001</u>

Burden Hour Statement: this form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount
of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND
FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box Patent Application, Washington, DC 20231.
SKGF Rev 2/14/01 mac SBO5.trans

PATENT APPLICATION SERIAL NO. _____

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE
FEE RECORD SHEET

04/11/2001 EFLORES 00000078 09829066

01 FC:101	710.00 OP
02 FC:103	900.00 OP